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Registered Representative

/Steven P. Shurtz/

Signature

October 17, 2005

Date of Signature

Our Case No. 1391/1275

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

McHale et al.

Serial No. 08/044,240

Filing Date: April 7, 1993

For Multi-Phase Sheeted Chewing Gum  
and Method of Apparatus For Making

Examiner: Keith D. Hendricks

Group Art Unit No.: 1761

**APPEAL BRIEF**

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Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is an appeal from the Final Rejection dated February 14, 2005, of claims 1-6, 9, 15, 28 and 65-68, all the rejected claims pending in the above captioned case. Claims 8, 10 and 51-56 were listed as appealed in the Notice of Appeal filed June 16, 2005, but those claims have since been allowed.

## **I. REAL PARTY IN INTEREST**

The present application is owned by Amurol Confections Company, which is a wholly owned subsidiary of the Wm. Wrigley Jr. Company.

## **II. RELATED APPEALS AND INTERFERENCES**

There are no related Interferences for this case. This case was formerly on appeal. Appeal No. 1997-2410, decided March 17, 2000, reversed a previous rejection of claims 1-6, 8, 15-19, 21, 28, 51-54 and 56. A copy of the decision is attached hereto in the Related Proceedings Appendix.

## **III. STATUS OF CLAIMS**

Claims 1-28, 51-56 and 65-68 are pending. Claims 29-50 and 57-64 were previously cancelled. Claims 1-6, 9, 15, 28 and 65-68 are rejected, and are all being appealed. Claims 8, 10, 18-21 and 51-56 have been allowed. Claims 7, 11-14, 16-17 and 22-27 have been withdrawn.

## **IV. STATUS OF AMENDMENTS**

All previously filed amendments have been entered. An advisory action mailed October 11, 2005 noted that the Response mailed August 16, 2005, would be entered and overcame the rejections under 35 U.S.C. § 112, second paragraph, in the Final Rejection.

## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

The claimed invention relates to sheeted chewing gum products that include more than one component, such as different colors. Novel forms of chewing gum are popular with consumers. Over the years, several novel chewing gum and confection products have been introduced. For example, a product sold under the trademark "BUBBLE TAPE®" bubble gum and made by the process described in U.S. Pat. No. 4,882,175 is a six foot roll of bubble gum rolled up in a tape. Also, a product sold under the name "Fruit Stripes®" chewing gum by Beechnut is printed with a dye so as to have colored stripes running diagonally across a stick of chewing gum. Specification, page 1, lines 8-29.

Referring to FIG. 1, a multi-colored sheeted chewing gum product 11 is shown in the form of a rolled up tape such as that described in U.S. Pat. No. 4,882,175.

Referring also to the cross-section in FIG. 2, it can be seen that this novel chewing gum product includes a first mass of chewing gum 13 and a second mass of a confectionery product 15 which has a different color from the first mass and which is embedded in and visible from the top surface of the first mass. When the gum is cut through a stripe of the second mass, the second mass may be visible from a side edge, such as shown at 17, but is not visible from the bottom surface of the gum product. The second mass is formed from a confectionery product, selected from a wide variety of products so long as it is compatible with the chewing gum in the first mass. Preferably, the confectionery product is chewing gum. One feature of the product of the present invention is that it is multi-colored, that is, the second mass has a different color from the first mass. Preferably, the colors are selected so as to show a distinct contrast. Specification, page 5, line 12 to page 6, line 9.

The second mass is in the form of a pattern. FIG. 1 shows an undulating, wavy pattern of the second mass running generally along the length of the first mass. FIG. 3 shows a tape of bubble gum 21 with a relatively straight stripe 23 of a second color of chewing gum embedded in the first mass 24 and running the length of the tape. FIG. 4 shows a stick of chewing gum 25 with stripes 27 of a second color of chewing gum embedded in the first mass 29, with the stripes 27 running across the width of the stick. FIG. 5 shows a pattern that includes diagonal lines 31 of the second mass embedded in the first mass 33 to make a diagonally striped stick of chewing gum 35. FIG. 6 shows a pattern that includes bits of the second mass 41 embedded in the first mass 43 to make the speckled or spotted stick of chewing gum 45. FIG. 7 shows a sheeted chewing gum with the first mass 53 and the bits of the second mass 51 formed into a disk 57 representing a pizza. In the FIG. 6 and 7 embodiments, it is preferred to use bits of a single color and flavor. However, the bits can also be made in different colors and flavors. Specification, page 6, line 10 to page 7, line 11.

While the method claims relating to the present invention have already been granted in U.S. Patent No. 5,538,742, a discussion of the general method by which the product can be made is helpful in understanding the product of the invention. In

addition, claim 15, which is on appeal, includes product-by-process limitations. Referring to FIG. 8, the first mass of chewing gum is formed into a slab 81 with a generally flat top surface. Preferably, this is accomplished by a conventional method in a conventional apparatus such as that shown in FIG. 8 at numeral 61. In this type of apparatus, the chewing gum is extruded into a slab about 12 inches wide and about 3/8 of an inch thick. After the first mass is formed into a slab with a generally flat top surface, at least one piece of a second mass of a confectionery product is brought into contact with the flat surface. Preferably, this is accomplished by extruding multiple, continuous ropes 83 (see FIG. 9) of the second mass and laying those ropes on top of the slab 81. Alternatively, individual pieces, bits or cut ropes of the second mass can be placed on top of the slab. Specification, page 8, line 17 to page 9, line 4.

The apparatus for forming the ropes 83 is shown at 63 in FIG. 8 and in more detail in FIGS. 9, 10, 11 and 12. Preferably, this second extruder 63 is equipped with a die 91 with multiple outlets 93 through which a plurality of continuous ropes 83 of the second mass are extruded. After exiting the die 91, the ropes pass over a roller 95 which is made with circumferential grooves 97 to receive the ropes 83, over roller 101, which also includes circumferential grooves 103, and under roller 106, which does not include circumferential grooves. As shown, the roller 106 is preferably biased toward the first slab. The ropes are flattened somewhat and pressed about half way into the first slab by the roller 106. As best seen in FIG. 11, the most preferred embodiment includes means for oscillating the ropes 83. This is accomplished by pushing the roller 101 back and forth across the width of the first slab while the ropes are held in the circumferential grooves 103. As a result, the ropes are laid down on the slab in an undulating or wavy pattern. Preferably, the second mass of confectionery product will comprise between about 2 and about 30 percent by weight of the total product, more preferably between about 4 and about 20 percent. After the slab and ropes are brought together, they pass underneath a device (not shown) which applies a dusting compound to the gum. Most preferably, the dusting compound is applied at this point in the line, namely after the first mass and second mass are brought together. In this way, it is difficult, if not impossible, for the consumer to separate the two masses in the final product. Alternatively, a dusting compound can be applied to the top of the slab before

the ropes of the second mass are applied. When this is done, the stripes of the second mass can be peeled out of the first mass in the final product. After the dusting compound is applied, the slab and the ropes pass through a series of rollers 71, 73, 75 and 77 (FIG. 8) which further flatten the slab and ropes, trim the width of the resultant sheet and score the sheet in the desired dimensions to produce the strips of chewing gum. Collectively, this series of rollers is referred to as a chewing gum sheeting machine. FIG. 13 shows a sheet 120 of multi-colored chewing gum after it exits the last roller 77 shown in FIG. 8. This sheet has been fully flattened, trimmed and scored so that it can be separated into the desired size and shape for the final piece of chewing gum. As can be seen in FIG. 12, after exiting the sheeting machine, the ropes of the second mass of chewing gum have been flattened into the first mass. Also, because the sheet has been flattened and stretched, the stripes 124 of the second mass have been widened and the undulations have been stretched out lengthwise. In addition, the score lines 122 pass through the undulations so that each final tape product will have undulations of the second mass passing in and out of the tape. This effect can also be seen in FIG. 1. One advantage of this effect is that the relatively random nature of the undulations produces a unique appearance at each point along the tape and also between different tapes. Specification, page 9, line 27 to page 12, line 21.

In a first aspect, the invention includes a multi colored, sheeted chewing gum product with a top and bottom surface, comprising:

- a first mass of chewing gum formed in a generally flat sheet; and

- a second mass of a confectionery product having a different color than the first mass, smaller than the first mass, and embedded in the first mass so as to be visible with the first mass from the top surface of the chewing gum product;

- the second mass being present in a pattern selected from the group consisting of an undulating pattern, a pattern of stripes across a width of the product, a diagonal pattern, a pattern of bits, and combinations of the foregoing;

- wherein the first mass only is visible from the bottom surface of the chewing gum product. See claim 1.

In a second aspect, the invention includes a multi-colored, sheeted chewing gum product with a top and bottom surface, comprising:

- a) a first mass of a chewing gum formed in a generally flat sheet; and
- b) a second mass of confectionery:
  - i) having a different color than the first mass,
  - ii) being smaller than the first mass,
  - iii) being embedded in the first mass so as to be visible with the first mass from the top surface of the chewing gum product,
  - iv) being present in an amount from 2 to 30 percent by weight of the total product, and
  - v) being present in a pattern;
- c) wherein the second mass is not visible from the bottom surface of the chewing gum product. See claim 67.

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

1. Claims 1, 2, 4, 5, 15, 65, 67 and 68 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Design Patent No. 271,344 (Faust).
2. Claims 3, 6, 9, 28 and 66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Faust in view of U.S. Patent No. 1,855,145 (Jones) and "Bubble Tape" and "Fruit Stripes" products referred to above and on page 1 of the specification.

## **VII. ARGUMENT**

### **A. Claims 1, 2, 4, 5, 15, 65, 67 and 68 are patentable under 35 U.S.C. § 102(b) over U.S. Patent No. Des. 271,344 (Faust)**

#### **1. Claims 1, 2, 4, 5, 15, 65, 67 and 68**

In the Final Rejection, claims 1, 2, 4, 5, 15, 65, 67 and 68 were rejected under 35 U.S.C. § 102 as anticipated by U.S. Patent No. Des. 271,344 (Faust). This rejection is improper and must be reversed. Faust discloses a two color chewing gum. There is no disclosure as to the make-up of the composition of the different parts of the product. However, a person of ordinary skill would assume that the darkly shaded areas of the product are made of the same material since they are similarly shaded. Claim 1 calls

for the second mass to be embedded in the first mass so as to be visible with the first mass from the top surface of the product, but the first mass only is visible from the bottom surface. Faust does not meet this limitation. In Faust, the description states that the rear perspective view and bottom view are, respectively, mirror images of the front perspective and top views shown. Hence the second color of chewing gum would be viewable from both the top and bottom surfaces, and both side surfaces. If an end surface is taken to be the top, then the "bottom" would be identical and show both colors. No matter which side is considered to be the top, the bottom will have both colors of chewing gum present.

The Final Rejection takes the position that the top dark mass is considered to be the second mass, and the bottom dark mass is considered to be a third mass. Hence, according to this interpretation, the second mass is not viewable from the bottom. It is clear from the present specification that the term "second mass" means a composition, but is not necessarily contiguous. In the specification the term "second mass" refers to a confectionary material that has a common composition (including color), not necessarily a contiguous material. For example, one page 2, lines 15-17, it states, "A second mass of a confectionary material is formed into at least one piece which is brought into contact with a generally flat sheet." Thus the second mass may clearly be multiple pieces as well as one piece, but the multiple pieces would have a common composition. Later, in the paragraph bridging pages 8 and 9, it is explained that one composition of a second mass can be applied to the first mass in separate ropes all made from the same composition. In that instance, even though there are multiple sections of this second composition, they are all referred to as being the second mass. Numerous other places in the specification use the term "second mass" in this same way. Thus, as interpreted in light of the present specification, the term "second mass" must be interpreted to mean all confectionery material in the product which has the same composition (different of course from the first mass), regardless of whether that confectionery material were present in one contiguous form or separated into different sections. Of course, the fact that different pieces of the second mass all have the same composition does not preclude the fact that some embodiments of products of the present invention may have additional compositions included. For example, page 7

lines 10-11 describe an embodiment where additional bits of confectionary of different colors and flavors may be included in a product along with the second mass bits.

When properly construed, claim 1 thus distinguishes over Faust in this regard. As noted above, Faust does not state that the top dark mass is different than the bottom dark mass. Nor is there anything that would make this inherent in Faust. On the contrary, since the Faust specification states that the drawings disclose a two color chewing gum, the top and bottom dark masses are at least the same color. Furthermore, a person of ordinary skill would presume that they had the same composition. Certainly there is nothing in Faust that inherently requires the top and bottom dark masses to have different compositions. Therefore, as the claim is interpreted in view of the specification, the top and bottom dark material in Faust would both be considered to be parts of the second mass. Since Faust clearly has something other than the first mass visible from the bottom surface, Faust does not anticipate claim 1.

There are several other differences between Faust and claim 1. Perhaps most important for the present invention is that Faust does not disclose the first mass of chewing gum being formed into a sheet. Applicants took the position that Faust discloses a chunk of gum, rather than a sheet. The Final Rejection states that "It is not clear how applicants determined that [Faust discloses] a chunk". This is readily apparent from simply looking at the relative dimensions of the product disclosed in Faust, and comparing that to the sheet products disclosed in the present specification. In a sheet, one dimension is thin compared to its other dimensions, such as in a stick of gum or a rolled up tape product disclosed in the present specification. In the depicted Faust product, the smallest dimension is over 50% as thick as the next smallest dimension, and still over 40% of the largest dimension. There is not one dimension that is thin compared to the other two dimensions.

Furthermore, other than questioning Applicants' description, the Final Rejection gives no support for the position that the shape shown in Faust would be considered a sheet by one of ordinary skill in the art. Finally, this issue was already raised in this case and previously decided in Applicants' favor. The Board of Appeals has construed the term "sheet" in claim 1 to mean something other than what is shown in a prior art



reference that is very similar in shape to Faust. See Decision of Board of Appeals mailed May 17, 2000, page 6, where it is stated that the square gum sections shown in Towae were not flat sheets. The same is true with Faust. The Final rejection has not provided any evidence that the chunk of gum disclosed in Faust is considered in the art to be a sheet.

Claim 67 has many of the same limitations as claim 1. For example, claim 67 states that the second mass is not visible from the bottom surface of the product. As explained above, a correct interpretation of Faust is that both the top and bottom dark areas are part of the second mass. Therefore the second mass is visible from the bottom in Faust. Claim 67 also requires that the first mass be in the form of a sheet. As explained above, Faust does not disclose a first mass in the form of a sheet. Thus claim 67 is not anticipated by Faust.

Claims 2, 4, 5, 65 and 68 are dependent on claims 1 and 67, and thus also differ from Faust in the same manner as discussed above.

## **2. Claims 1, 2, 4, 5, 15, 65 and 68**

Claim 1 also requires that the second mass is present in a pattern selected from the group consisting of an undulating pattern, a pattern of stripes across a width of the product, a diagonal pattern, a pattern of bits, and combinations of the foregoing. Faust does not disclose any of these patterns, and especially not a pattern of stripes across a width of the product, which is the portion of the Markush group presently under consideration and which is specifically called for by claim 4. Faust discloses two portions of a second mass going in the same direction as the length of the chunk. While it may be argued that the height and width of the product in Faust can easily be changed by rotating the product, the length of a rectangular solid is always considered to be its longest dimension. Thus the width has to be one of the other two dimensions, and the two portions of the second mass are not stripes across either of these two shorter dimensions. Further, the position in the Final Rejection that the bottom dark mass is a third mass would mean that there is only one stripe of the second mass in Faust, so if this interpretation of the prior art is taken, the second mass in Faust is not in the form of a plurality of stripes. For all of these reasons, claims 1 and 4 are not anticipated by Faust. Claims 2, 5, 15 and 65 are dependent on claim 1 and also differ

from Faust in this same regard. In addition, claim 68 specifically requires the second mass to be present in a pattern of stripes across the width of the product. Thus these claims are further patentable over Faust.

### **3. Claims 5 and 65**

Claims 5 and 65 require that the first mass is formed into an elongated strip. Faust does not disclose an elongated strip, and claims 5 and 65 are patentable for this further reason.

### **4. Claim 65**

Claim 65 requires that the stripes of the second mass are generally perpendicular to the direction of elongation of the strip. Faust clearly does not teach this feature. Claim 65 is thus further patentable over Faust.

### **5. Claim 15**

Claim 15 includes two sets of limitations, the product limitations from claim 1 and the process limitations explicitly recited in claim 15. Since claim 1 is patentable over Faust, claim 15 is also patentable over Faust for at least the same reasons. MPEP 2173.05 (p) indicates that product-by-process claims may be utilized to present claims of varying scope. This inherently requires that the process limitations be given patentable weight. While claim 15 has been shown to be patentable over Faust regardless of the process limitations, it is also clear that the product of Faust would not suggest the steps of bringing at least one piece of a second mass of confectionary product into contact with a flat surface of a slab of chewing gum and pressing the slab to form a generally flat sheet with the second mass embedded in it, as required by claim 15. Hence claim 15 is not anticipated by Faust for this further reason.

## **B. Claims 3, 6, 9, 28 and 66 are patentable over U.S. Patent No. Des. 271,344 (Faust) in view of U.S. Patent No. 1,855,145 (Jones) and “Bubble Tape” and “Fruit Stripes” products referred to on page 1 of the specification**

### **1. Claims 3, 6, 9, 28 and 66**

In the Final Rejection, claims 3, 6, 9, 28 and 66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. Des. 271,344 (Faust) in view of U.S. Patent No. 1,855,145 (Jones) and further in view of the “Bubble Tape” and “Fruit

Stripes” products referred to above and on page 1 of the specification. This rejection is also improper and must also be reversed.

The Final Rejection takes the position that Faust discloses two layer chewing gums with one embedded in the other so that the top layer is not viewable from the bottom. Claims 3, 6, 9, 28 and 66 are all dependent on claim 1. As noted above, claim 1 requires the second mass to be embedded in the first mass so as to be visible with the first mass from the top surface of the product, but the first mass only is visible from the bottom surface. Also as noted above, Faust does not meet this limitation. No matter which side is considered to be the top, the bottom will have both colors of chewing gum present.

Jones discloses an edible article such as a candy bar. The form of the product, and the use of two different materials to make it, is such that the eater is compelled to automatically partake of the product such that each bite has a different composition than the previous bite, thus overcoming the problem that the sense of taste becomes saturated in a small amount of time, and the last bite of a candy bar does not taste as good as the first. Figure 10 of Jones discloses a bar having a constant proportion of one material formed as a base upon which is placed a bar having a progressively changing composition.

Jones would not suggest to one of ordinary skill in the art to modify the chewing gum product of Faust to come up with the claimed invention. First, the Jones idea would not even be applicable to chewing gum, which is not swallowed bite after bite as would be the product in Jones. Since the two-color chewing gum product of Faust would normally be placed in the mouth all at once, and chewed over a period of time, there would be no advantage to putting one color of chewing gum in the form of a stripe so that each bite has a different composition. Second, the product of Faust is a chunk of gum, rather than a bar product as used in Jones. Third, chewing gum is quite different than the candy bar, cake and ices disclosed in Jones, therefore it would not have been obvious to apply the teachings of Jones to the Faust product.

The Final Rejection argues that “Merely because cake confections are different from gum confections does not eliminate the obviousness of their combined teachings. Both technologies stem from the confection art.” This argument fails to appreciate that

the two products are consumed in completely different ways. Chewing gum is by definition designed to have a portion that stays in the mouth as the product is chewed. As a result, serving sizes of chewing gum of the type disclosed in Faust are provided so that they are placed in the mouth all at once, rather than bitten off and swallowed in steps as are the candy bars of Jones. Thus the suggested motivation to combine the teachings of the references so that as a consumer bites the gum a changed composition is encountered has no basis in reality.

In order for a *prima facie* case of obviousness to be established, the teachings from the prior art itself must suggest the claimed subject matter to one of ordinary skill in the art. The mere fact that the prior art could be modified as proposed in the Final Rejection is not sufficient to establish a *prima facie* case of obviousness. The Final Rejection must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). Because the reasoning for making the combination in the Final Rejection has been shown to be faulty, it is clear that the rejection is thus based on impermissible hindsight reconstruction of the invention.

The Bubble Tape and Fruit Stripes products do not make the invention of claim 1 obvious. Bubble Tape does not include multiple components, so the concept of a pattern on one side and no pattern from the bottom could not be suggested by the product. Furthermore, one would not combine Faust and Bubble Tape to produce an elongated, flattened version of the design of Faust, since in so doing the design of Faust, which is intended to be a finished product, would be distorted. Furthermore, the product would have both colors showing on both the top and bottom surfaces, which as discussed above is opposite to the requirements of claim 1. Fruit Stripes has a stripe that shows on both sides. Thus any motivation to make a product with diagonal stripes would also be a motivation to make a product with stripes on both sides. Only Figure 10 of Jones is a product with one composition entirely making up a base and two compositions making up a top surface. However, while such a product could be readily formed using a chocolate base, it would not be obvious even from Jones of how to make such a product where the first mass is chewing gum. If one wanted to follow the teachings of Jones and make a chewing gum product, at best the product would be like

the other embodiments in Jones, where both colors are apparent from both sides. It would not have been obvious to make a product like Fig. 10 of Jones using the chewing gum of Faust.

A previous Office Action argued that there would be motivation from Jones to modify an elongated rolled up tape product so that “a changed composition is encountered”. However, the product in Jones was made of two different compositions that tasted differently. The product of Faust at most has two different colors. There is no suggestion that two different compositions be used that taste differently. Thus, even if someone were to make the product of Faust into an elongated rolled up tape, since both compositions would taste the same, the idea behind Jones of varying the amount of one composition compared to the other in each bite would not even be applicable. Hence there would be no motivation to modify the elongated tape to have different colors present in different amounts at different longitudinal positions along the tape.

An earlier Office Action cited *In re Levin*, 84 U.S.P.Q. 232 as supporting the rejection. However, that case is not applicable to the present claims. Levin deals with a new recipe or formula for cooking food. The present claims deal with a structure and configuration of an edible material, not the recipe or formula for making the individual first and second masses.

Since it would not have been obvious from the cited references to come up with the invention of claim 1, claims 3, 6, 9, 28 and 66 dependent thereon are patentable over the cited references.

## **2. Claim 28**

Claim 28 is dependent on claim 15, and like claim 15 is patentable over Faust for additional reasons. None of the secondary references suggest the method steps required by claim 15, and hence of claim 28, let alone the further method steps of not using a rolling compound between the first mass of chewing gum and the second mass of confectionary material so that the two are not separable by the consumer, as called for in claim 28. Thus claim 28 is further patentable over the cited references.

## **3. Claim 66**

Claim 66 requires that the pattern of stripes comprise at least three stripes. Faust clearly does not teach this feature, nor do any of the other secondary references. Claim 66 is thus further patentable over the cited references.

### **VIII. CONCLUSION**

Appellants have made a novel and nonobvious contribution to the art of sheeted chewing gum products. The claims at issue distinguish over the cited references. The present invention is not obvious in view of the cited prior art. The references are being combined based solely on hindsight reconstruction of the invention. A person of ordinary skill in the art would not combine the references as suggested in the Final Rejection.

Appellants submit that the present invention is fully patentable over the cited references and the Examiner should be REVERSED.

Respectfully submitted,

/Steven P. Shurtz/

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Dated: October 17, 2005

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## CLAIMS APPENDIX

### CLAIMS ON APPEAL

1. A multi colored, sheeted chewing gum product with a top and bottom surface, comprising:
  - a first mass of chewing gum formed in a generally flat sheet; and
  - a second mass of a confectionery product having a different color than the first mass, smaller than the first mass, and embedded in the first mass so as to be visible with the first mass from the top surface of the chewing gum product;
  - the second mass being present in a pattern selected from the group consisting of an undulating pattern, a pattern of stripes across a width of the product, a diagonal pattern, a pattern of bits, and combinations of the foregoing;
  - wherein the first mass only is visible from the bottom surface of the chewing gum product.
2. The chewing gum product of claim 1 wherein the confectionery product is chewing gum.
3. The chewing gum product of claim 2 wherein the first and second masses of chewing gum are different flavors.
4. The chewing gum product of claim 1, wherein the second mass is present in a pattern of stripes across the first mass.
5. The chewing gum product of claim 1 wherein the first mass is formed into an elongated strip.
6. The chewing gum product of claim 5 wherein the strip is in the form of a rolled up tape.
9. The chewing gum product of claim 1 wherein the second mass is present in a striped diagonal pattern across the product.

15. The multi phase chewing gum product of claim 1, prepared according to a method comprising the steps of:

forming the first mass of chewing gum into a slab with a generally flat surface;

forming the second mass of the confectionery product into at least one piece;

bringing the piece into contact with the flat surface;

pressing the slab and piece to form the generally flat sheet; and

cutting said generally flat sheet into segments of a desired width, length and shape.

28. The chewing gum product of claim 15 wherein no rolling compound is placed between the first mass of chewing gum and the second mass of confectionery material so that the two are not separable by the consumer.

65. The chewing gum product of claim 5 wherein the pattern of stripes of the second mass are generally perpendicular to the direction of elongation of the strip.

66. The chewing gum product of claim 1 wherein the pattern of stripes comprises at least three stripes.

67. A multi-colored, sheeted chewing gum product with a top and bottom surface, comprising:

a) a first mass of a chewing gum formed in a generally flat sheet; and

b) a second mass of confectionery:

i) having a different color than the first mass,

ii) being smaller than the first mass,

iii) being embedded in the first mass so as to be visible with the first mass from the top surface of the chewing gum product,

iv) being present in an amount from 2 to 30 percent by weight of the total product, and

v) being present in a pattern;



c) wherein the second mass is not visible from the bottom surface of the chewing gum product.

68. The chewing gum product as claimed in claim 67 wherein the second mass is present in a pattern of stripes across the width of the product.

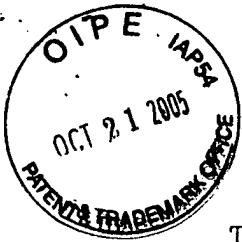
## EVIDENCE APPENDIX

None

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## RELATED PROCEEDINGS APPENDIX

A copy of the decision (11 pages in length) mailed March 17, 2000, for Appeal No. 1997-2410 for this same application, reversing a previous rejection of claims 1-6, 8, 15-19, 21, 28, 51-54 and 56 is attached hereto.



THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion, in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 30

MAILED

UNITED STATES PATENT AND TRADEMARK OFFICE

MAR 17 2000

PAT.&T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* MICHAEL McHALE, GEORGE NICHTULA,  
CHRISTINE L. CORRIVEAU and WILLIAM J. WOKAS

Appeal No. 1997-2410  
Application 08/044,240

ON BRIEF

Before WILLIAM F. SMITH, GARRIS and OWENS, *Administrative Patent Judges.*

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 51-54 and 56, and refusal to allow claims 1-6, 8, 15-19, 21 and 28 as amended after final rejection. Claims 7, 9-14, 20, 22-27, 29-50 and 55 stand withdrawn from consideration by the examiner as being directed toward a nonelected invention. These

are all of the claims remaining in the application.

*THE INVENTION*

Appellants' claimed invention is directed toward multicolored sheeted chewing gum products wherein a sheet or slab of chewing gum has a design of a confectionary material embedded therein. Claims 1 and 51 are illustrative and read as follows:

1. A multi-colored, sheeted chewing gum product with a top and bottom surface, comprising:

a first mass of chewing gum formed in a generally flat sheet; and

a second mass of a confectionery product having a different color than the first mass, smaller than the first mass, and embedded in the first mass so as to be visible with the first mass from the top surface of the chewing gum product;

the second mass being present in a pattern selected from the group consisting of an undulating pattern, a pattern of stripes across a width of the product, a diagonal pattern, a pattern of bits, and combinations of the foregoing;

wherein the first mass only is visible from the bottom surface of the chewing gum product;

51. A multi-colored, sheeted chewing gum product, comprising:

a slab of a first chewing gum having a first flat surface and a second surface; and

a rope of a second confectionery material embedded into the slab of first chewing gum;

the rope being present in an undulating pattern;

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wherein the embedded rope of second confectionery material is visible at the first flat surface in said undulating pattern.

#### *THE REFERENCES*

Cherukuri et al. (Cherukuri)	4,971,806	Nov. 20, 1990
Towae <sup>1</sup> (German patent application)	3,516,852	Nov. 14, 1985

#### *THE REJECTIONS*

Claims 1-6, 8, 15-19, 21, 28, 51-54 and 56 stand rejected under 35 U.S.C. § 103 as being unpatentable over Towae and also over Cherukuri in view of Towae.

#### *OPINION*

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejections are not well founded. Accordingly, we reverse these rejections.

In response to the examiner's election of species requirement (mailed December 27, 1993, paper no. 3), appellants elected (response filed March 15, 1994; paper no. 6) the product made by the process of example 1 of appellants' specification. The examiner has interpreted this example as producing a product

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<sup>1</sup> This reference is referred to by the examiner as "Lorenz". Our consideration of this reference is based upon the English translation thereof which is of record.

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in which the second mass has an undulating pattern (Office action mailed May 10, 1994, paper no. 7, page 4; examiner's answer, page 7).

Appellants argue that the election of species requirement was improper because the examiner did not set forth a proper basis for the requirement, and further argue that the examiner improperly withdrew from consideration some claims which are directed toward the elected species (brief, pages 6-13). The propriety of the restriction requirement and the examiner's grouping of claims in response thereto are petitionable issues rather than appealable issues and, therefore, are not before us for consideration. See *Manual of Patent Examining Procedure* § 1002.02(c)(2) (7th ed., July 1998). Thus, we limit our consideration to the rejected claims. Although appellants' claim 1 recites a number of patterns in which the second mass can be present, we consider only the undulating pattern to which, the record indicates, the examination was limited. See *Ex parte Ohsaka*, 2 USPQ2d 1460, 1461 (Bd. Pat. App. & Int. 1987). We need to address only the independent claims, which are claims 1 and 51.

*Rejection over Towae*

Towae discloses an extruder for extruding materials which are semifluid when processed warm, such as chewing gum pastes, to make products having multiple colors and shapes (pages 3-4). The portion of the reference relied upon by the examiner is figure 7 which shows twelve cross sectional shapes which can be formed using the extruder (pages 7 and 13).

Regarding claim 1 the examiner argues that the fifth and sixth square gums shown in Towae's figure 7 have a first mass which is a generally flat sheet, a second mass which is visible from one side of the sheet, and a third mass, separate and distinct from the second mass, which is visible from the other side of the sheet (answer, page 6).<sup>2</sup> Appellants argue that Towae's square gums are too thick to be characterized as sheets and that the second mass is visible from opposite sides of the squares (brief, pages 15-16). The examiner responds that one could modify the extrusion process for producing the fifth pattern such that the second mass is extruded on only one surface, or could cut the first mass horizontally just below the

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<sup>2</sup> The examiner does not state which of the patterns in figure 7 the examiner considers to be the fifth and sixth patterns. It appears from the examiner's argument that the fifth and sixth patterns referred to by the examiner are the middle and lowest patterns in the second column of patterns in the figure.



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top second mass so that the top second mass is visible from the top and not from the bottom (answer, page 11).

The examiner's arguments are not well taken because the examiner has provided no evidence that square gums such as those of Towae were considered in the art to be flat sheets or that the reference would have led one of ordinary skill in the art to modify the extrusion process or cut the gums as proposed by the examiner. In order for a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The examiner must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. See *Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1783-84.

Moreover, the examiner has not explained why Towae would have led one of ordinary skill in the art to form an undulating pattern of the second mass as required by both claims 1 and 51. As pointed out by appellants (brief, page 15), Towae's coextrusion process produces stripes which are parallel to the length of the products. The examiner argues that a person at home could produce an undulating pattern with a rolling pin and a knife (answer, page 7). This is not a convincing argument because the examiner has not explained why one of ordinary skill in the art would have been led by Towae to substitute a rolling pin and knife for his extruder. The examiner argues that it would have been obvious to one of ordinary skill in the art to modify the second mass such that it has an undulating pattern because such a person was "fully aware that consumers take pleasure in consuming confections of various designs" (answer, page 7). This argument is not persuasive because the examiner has not explained why, even if one of ordinary skill in the art desired an undulating pattern, such a person would have been enabled by Towae to modify the extruder such that it produces an undulating pattern. Appellants argue that because Towae's extrusion die is fixed, it is not possible to oscillate one of the streams relative to the other such that an undulating pattern

is formed (brief, pages 24-25). This is a plausible argument which has not been rebutted by the examiner with evidence or technical reasoning.

For the above reasons, we conclude that the examiner has not carried the burden of establishing a *prima facie* case of obviousness over Towae of the invention recited in any of the rejected claims.

*Rejection over Cherukuri in view of Towae*

Cherukuri discloses a multilayered chewing gum in which one layer has a high initial flavor release and the other layer has a longer lasting flavor release (col. 1, lines 15-18). The gum layers are formed by conventional methods such as coextrusion or roller pressing (col. 2, lines 31-32). In one embodiment, ropes of gum are braided and rolled into sheets (col. 9, lines 42-45).

The examiner argues that Cherukuri's table III shows first layers having different colors from second layers, and argues that since a multicolored design is viewable by the consumer (col. 2, lines 66-68), one of the layers must be larger than the other layer (answer, page 9). This argument is not persuasive because Cherukuri merely discloses that conventional techniques are used to laminate layers together. The examiner has not established that the teaching that the multicolored design is

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viewable would have indicated to one of ordinary skill in the art that one layer is smaller than the other rather than indicating that there are two conventional equal sized layers having different colors which are viewable sequentially or from the side.

The examiner argues that forming a design of one of Cherukuri's layers would have been obvious to one of ordinary skill in the art in view of Towae (answer, page 9). This argument is not convincing because the examiner has not explained why Cherukuri and Towae would have led one of ordinary skill in the art to form an undulating design of one layer embedded in another and would have enabled such a person to do so. See *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988).

For the above reasons, we find that the examiner has not set forth a factual basis which is sufficient for supporting a conclusion of obviousness over Cherukuri in view of Towae of the invention recited in any of the rejected claims.

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### DECISION

The rejections of claims 1-6, 8, 15-19, 21, 28, 51-54 and 56 under 35 U.S.C. § 103 over Towae and over Cherukuri in view of Towae are reversed.

*REVERSED*

William F. Smith

WILLIAM F. SMITH  
Administrative Patent Judge

BRADLEY R. GARRIS

BRADLEY R. GARRIS  
Administrative Patent Judge

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